

REMARKS

Summary

Claims 1, 4-7 and 12-25 stand in this application. Claims 2, 3 and 8-11 have been canceled without prejudice. Independent claims 1, 7, 19 and 22 have been amended. No new matter has been added. Favorable reconsideration and allowance of the standing claims are respectfully requested.

Although Applicant disagrees with the broad grounds of rejection set forth in the Office Action, Applicant has amended independent claims 1, 7, 19 and 22 in order to facilitate prosecution on the merits.

35 U.S.C. § 103

At page 2, paragraph 2 of the Office Action claims 1, 4-7, 9 and 12-25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over US 5,619,247 to Russo ("Russo") in view of US 4,945,563 to Horton et al. ("Horton") and further in view of US 5,987,518 to Gotwald ("Gotwald"). Applicant respectfully traverses the rejection, and requests reconsideration and withdrawal of the obviousness rejection.

The Office Action has failed to meet its burden of establishing a *prima facie* case of obviousness. According to MPEP § 2143, three basic criteria must be met to establish a *prima facie* case of obviousness. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the reference (or references when combined) must teach or suggest all the claim limitations. The teaching

or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaech*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP 706.02(j).

As recited above, to form a *prima facie* case of obviousness under 35 U.S.C § 103(a) the cited references, when combined, must teach or suggest every element of the claim. See MPEP § 2143.03, for example. Applicant respectfully submits that the Office Action has not established a *prima facie* case of obviousness because the cited references, taken alone or in combination, fail to teach or suggest every element recited in claims 1, 4-7 and 12-25. Therefore claims 1, 4-7 and 12-25 define over Russo, Horton and Gotwald whether taken alone or in combination. For example, claim 1 recites the following language, in relevant part:

a descriptor embedded in the received broadcast content, the descriptor to indicate whether the storage device may store the received broadcast content prior to viewing and without reproducing the received broadcast content, and once stored, a number of times the playback device may reproduce the received broadcast content.

As correctly noted in the Office Action on page 4, paragraph 7, Russo "fails to show that the descriptor information indicates the number of times the received broadcast content may be consumed." The Office Action alleges that limiting the number of times the received broadcast may be consumed would have been obvious to one of ordinary skill in the art at the time the invention was made. Applicant respectfully disagrees. Applicant respectfully submits that Russo, at column 5, lines 33-48, in relevant part, states:

viewer may be allowed to view a selected program as many times as desired over a particular, predetermined period of

time without incurring any additional charges. ...enables a renter to view the program as many times as desired until the cassette is due back at the store. Thus the system according to this invention may keep track of such time periods, and, if the viewer chooses to keep a particular program in the storage library beyond this time period, further viewing may be treated as an additional "rental" of that program having the same or, perhaps, reduced charges associated with the viewing thereof.

Russo, however, fails to teach, suggest or disclose indicating "a number of times the playback device may reproduce the received broadcast content" as recited in independent claim 1. Applicant respectfully submits that allowing a selected program to be viewed as many times as desired for a predetermined period of time, as taught by Russo, is different than restricting "a number of times the playback device may reproduce the received broadcast content."

Applicant respectfully submits that Russo actually teaches away from limiting the number of times broadcast content may be reproduced. Russo teaches allowing a program to be viewed "as many times as desired over a particular, predetermined period of time." Consequently, Applicant respectfully submits that it would not have been obvious to combine the teaching of Russo with that of Horton and Gotwald because Russo teaches away from the language of claim 1. Applicant respectfully submits that Horton and Gotwald also fail to teach, suggest or disclose the missing language. Therefore, Russo, Horton and Gotwald, taken alone or in combination, fail to teach, suggest or disclose each and every element recited in amended independent claim 1.

Moreover, Applicant respectfully submits that the cited references, taken alone or in combination, also fail to teach suggest or disclose "a descriptor embedded in the received broadcast content, the descriptor to indicate whether the storage device may

store the received broadcast content prior to viewing and without reproducing the received broadcast content” as recited in independent claim 1. According to the Office Action, the missing language is disclosed by Horton at column 3, lines 38-67. Applicant respectfully disagrees. Horton at the given cite, in relevant part, states:

The receiver 20 includes a descrambling circuit 26 which descrambles the television program and feeds it to a decoder 28. The decoder 28 decodes the coded information embedded in the TV signal and provides an indication to an operator of the various modes available with this particular program. ...The modes which may be made available include view only, view and tape for fee, and view and tape for free. Depending upon the mode selected, the TV program will then be routed along conductor 34 corresponding to view and tape for free; or through the copy protect circuit 36 where it would be formatted for view and tape for a fee; or through antitape circuitry 38 where it would be formatted for view only....

By way of contrast, the claimed subject matter teaches “a descriptor embedded in the received broadcast content, the descriptor to indicate whether the storage device may store the received broadcast content prior to viewing and without reproducing the received broadcast content.”

Applicant respectfully submits that Horton, arguably, teaches the view only, view and tape for fee and view and tape for free modes. Each of these steps involves viewing the descrambled television program. In contrast, the language of claim 1 allows the storage device to “store the received broadcast content prior to viewing and without reproducing the received broadcast content.” Therefore, Horton fails to disclose, teach or suggest the missing language. Applicant respectfully submits that Russo and Gotwald also fail to disclose the missing language. Consequently, Russo, Horton and Gotwald,

whether taken alone or in combination, fail to disclose, teach or suggest every element recited in claim 1.

Furthermore, if an independent claim is non-obvious under 35 U.S.C. § 103, then any claim depending therefrom is non-obvious. *See* MPEP § 2143.03, for example. Accordingly, removal of the obviousness rejection with respect to claim 1 is respectfully requested. Claims 4-6 also are non-obvious and patentable over Russo, Horton and Gotwald, taken alone or in combination, at least on the basis of their dependency from claim 1. Applicant, therefore, respectfully requests the removal of the obviousness rejection with respect to these dependent claims.

Independent claims 7, 19 and 22 have been amended to recite features similar to those recited in amended independent claim 1. Therefore, Applicant respectfully submits that claims 7, 19 and 22 are not obvious and are patentable over Russo, Horton and Gotwald, taken alone or in combination, for reasons analogous to those presented with respect to claim 1. Accordingly, Applicant respectfully requests removal of the obviousness rejection with respect to claim 7, 19 and 22. Furthermore, Applicant respectfully requests withdrawal of the obviousness rejection with respect to claims 12-18, 20-21 and 23-25 that depend from claims 7, 19 and 22 respectively, and therefore contain additional features that further distinguish these claims from Russo, Horton and Gotwald.

For at least the reasons given above, claims 1, 4-7 and 12-25 are non-obvious and represent patentable subject matter in view of the cited references, whether taken alone or in combination. Accordingly, removal of the obviousness rejection with respect to claims 1, 4-7 and 12-25 is respectfully requested. Further, Applicant submits that the above-

recited novel features provide new and unexpected results not recognized by the cited references. Accordingly, Applicant submits that the claims are not anticipated nor rendered obvious in view of the cited references.

Applicant does not otherwise concede, however, the correctness of the Office Action's rejection with respect to any of the dependent claims discussed above. Accordingly, Applicant hereby reserves the right to make additional arguments as may be necessary to further distinguish the dependent claims from the cited references, taken alone or in combination, based on additional features contained in the dependent claims that were not discussed above. A detailed discussion of these differences is believed to be unnecessary at this time in view of the basic differences in the independent claims pointed out above.

It is believed that claims 1, 4-7 and 12-25 are in allowable form. Accordingly, a timely Notice of Allowance to this effect is earnestly solicited.

The Examiner is respectfully requested to contact the undersigned by telephone if such contact would further the examination of the present patent application.

Respectfully submitted,
KACVINSKY LLC



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Under 37 CFR 1.34(a)

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